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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,432	04/06/2001	Gabriel Vogeli	00145.US1	6178

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EXAMINER	
ULM, JOHN D	
ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/828,432	Vogeli et al.
Examiner	**Art Unit**
John Ulm	1646

-- ***The MAILING DATE of this communication appears on the cover sheet with the correspondence address*** --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-81* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-81* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s).
4) ☐ Interview Summary (PTO-413) Paper No(s).
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1) Claims 1 to 81 are pending in the instant application.

2) Claims 30 to 39, 44, 47, 52, 67 and 68 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A properly dependant claim can not conceivably be infringed without infringing any of the claims from which it depends. Applicant is advised that claims 44, 47, 52, 67 and 68 are not product-by-process claims because the processes referred to therein are analytical, not synthetic. See M.P.E.P. 608.01(n)III. Correction is required.

3) Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 to 21, 25 to 29 and 67 to 72, drawn to an isolated nucleic acid molecule encoding a polypeptide, and a method of use, classified in class 435, subclass 69.1.

II. Claims 22 to 25 and 65, drawn to a nucleic acid probe, classified in class 536, subclass 24.31.

III. Claims 30 to 35, drawn to an isolated polypeptide, classified in class 530, subclass 350.

IV. Claims 36 to 38, drawn to an antibody, classified in class 530, subclass 388.22.

V. Claim 39, drawn to a method of inducing an immune response by administering a polypeptide, classified in class 424, subclass 185.1.

VI. Claims 40 to 43 and 48 to 51, drawn to a ligand binding assay employing a polypeptide, classified in class 435, subclass 7.1.

VII. Claims 44 and 52, drawn to a compound of unspecified constitution which is binds to a polypeptide, classification undeterminable.

VIII. Claims 45 and 46, drawn to a binding assay employing an isolated nucleic acid, classified in class 436, subclass 94.

IX. Claim 47, drawn to a compound of unspecified constitution which is binds to an isolated nucleic acid, classification undeterminable.

X. Claims 53 to 55, drawn to a method of identifying a nucleic acid sequence encoding a homolog of a polypeptide, classification undeterminable.

XI. Claims 56 to 64 and 66, drawn to a diagnostic method of genetic analysis employing a nucleic acid probe. classified in class 435, subclass 6.

XII. Claim 73 to 77, drawn to a binding assay employing a cell comprising a recombinant nucleic acid encoding a polypeptide, classified in class 435, subclass 7.2.

XIII. Claims 78 to 81, drawn to a method of purifying a G protein by employing a polypeptide, classified in class 435, subclass 815.

The inventions are distinct, each from the other because:

The two different nucleic acids that are inventions I and II, the protein of invention III, the antibody that is invention IV, and the two different binding compounds that are inventions VII

and IX are six different chemical compounds each of which can be made and used without any of the other compounds. These six different compounds lack unity of invention because they have no common utility which is based upon a shared structural feature lacking from the prior art and disclosed as a basis for that common utility.

The nucleic acid of invention I is related to the nucleic acid binding assay of invention VIII and the ligand binding assay of invention XII as product and two materially different processes of using that product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the binding assay of invention VIII is materially different from the ligand binding assay of invention XII because they achieve different results by employing different process steps.

The nucleic acid probe of invention II is related to the method of identifying a nucleic acid sequence encoding a homolog that is invention X and the diagnostic method of invention XI as product and two materially different processes of using that product. The searching method of invention X is materially different from the diagnostic method of invention XI because they achieve different results by employing different process steps.

The protein of invention III is related to the method of inducing an immune response that is invention V, the binding assay of invention VI and the method of purifying a G protein that is invention XIII as product and three materially different processes of using that product. The

method of inducing an immune response that is invention V, the binding assay that is invention VI and the method of purifying a G protein that is invention XIII are three materially different processes of using a common product because those processes achieve different results by employing different process steps.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.